

R-2001-140



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

JAN 5 2001

In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to question 49 of the morning section and questions 16 and 49 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 29, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning question 49 and afternoon questions 16 and 49.

Petitioner's arguments for these questions are addressed individually below.

Morning question 49 reads as follows:

49. Which of the following statements is NOT true?

- (A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.
- (B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.
- (C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.
- (D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.
- (E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

The model answer is choice is (A). A patent practitioner may refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. See 37 C.F.R. §10.84(b)(2).

Petitioner argues that choice (B) is also correct. Petitioner argues that choice (B) is a false statement because its recitations of "patent practitioner" and "patent law" are narrower than the recitations of "practitioner" and "patent, trademark, or other law" in 37 C.F.R. § 10.49. Petitioner further points to the different definitions given to the term "practitioner" in the examination instructions (any reference to a practitioner is a reference to a registered patent practitioner) versus 37 CFR § 10.1(r) (*Practitioner* means (1) an attorney or agent registered to practice before the Office in patent cases or (2) an individual authorized under 5 U.S.C. 500(b) or otherwise as provided by this subchapter, to practice before the Office in trademark cases or other non-patent cases). Petitioner argues that these differences render choice (B) a false statement.

Petitioner's arguments have been fully considered but they are not persuasive. A patent practitioner may not form a partnership with a "non-practitioner" if any of the activities of the partnership consists of the practice of patent law before the PTO. See 37 C.F.R. § 10.49. The use of the more limited terms "patent practitioner" and "patent law" in choice (B) does not render it any less true. The term "non-practitioner" is defined in 37 CFR § 10.1(r) as "an individual who is not a practitioner" (*i.e.* an individual who is not (1) an attorney or agent registered to practice before the Office in patent cases or (2) an individual authorized under 5 U.S.C. 500(b) or otherwise as provided by this subchapter, to practice before the Office in trademark cases or other non-patent cases). The term "non-practitioner" is not defined in the examination instructions. Further, while choice (B) includes the more limited terms "patent practitioner" and "patent law", it makes use of the broader term "non-practitioner" rather than the narrower term "non-patent practitioner." Choice (B) is a true statement.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10

days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner argues that the most correct answer is choice (E), because (A), (B), (C) and (D) are each incorrect. Petitioner argues that none of the statements regarding the relevance of "nearly simultaneous invention" by Debbie and Billie are correct. Petitioner asserts that since MPEP 2141.03 does not refer to "nearly simultaneous invention" as being evidence of the level of skill in the art, choice (B) is not correct. Petitioner further argues that since the MPEP, PCT, U.S. patent statutes, patent rules, and case law (listed in the examination instructions) do not refer to "nearly simultaneous invention", choices (A), (B), (C) and (D) are incorrect.

Petitioner's arguments have been fully considered but they are not persuasive. Nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention.

See *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) (...evidence of contemporaneous

invention is probative of "the level of knowledge in the art at the time the invention was made.").

See Also *International Glass Co. v. U.S.*, 159 USPQ 434, 442 (US ClCt 1968) (The fact of nearsimultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.). Therefore, choice (B) is correct, and choice (E) is incorrect.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

The model answer is choice is (E). The earliest effective filing date of application E with respect to any common subject matter in the prior applications is July 22, 1999.

Petitioner argues that the most correct answer is choice (A). Petitioner argues that the earliest effective filing date of application E with respect to any common subject matter in the prior applications is October 21, 1993. Petitioner argues that under Rule 134, an applicant has six months to respond to an Office Action, unless informed in "writing" of a shorter period. Since

the facts do not state that a three month shortened period was set, petitioner assumes applicant had six months to respond, and thus the applications were not abandoned until October 1999. It is petitioner's position that application E properly claims benefit to Applications B, C and D.

Petitioner's arguments have been fully considered but they are not persuasive. The applications C and D were abandoned after midnight of July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 ("If the first application is abandoned, the second application must be filed before the abandonment in order for it to be copending with the first."). See MPEP § 710.01(a), fourth paragraph. According to the instructions, "[t]he most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP). . . ." Under the authority given him by 35 U.S.C. 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. See MPEP 710.02(b). Since the Examiner would have followed the practice and procedure in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, and the MPEP, a shortened period of would have been set and applications C and D would have been abandoned after midnight of July 21, 1999. Therefore, there is no copendency and choice (E) is correct.

No error in grading has been shown as to morning questions 49 and afternoon questions 16 and 49. Petitioner's request for credit on these questions is denied. The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the

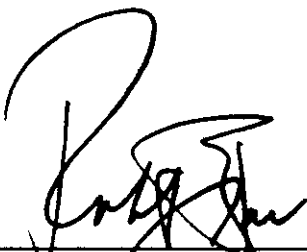
PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy